

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHINSAKU TANAKA and TOSHIO YOSHIMURA

Appeal No. 1998-0454
Application No. 08/417,985¹

HEARD: September 15, 1999

Before KRASS, MARTIN, and GROSS, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 6 under 35 U.S.C. 251 based on a broadening of

¹ Application for patent filed April 6, 1995. According to appellants, this application is a Reissue of Application No. 06/938,614, filed December 5, 1986, now U.S. Patent No. 4,779,147.

claims in a reissue application more than two years after the issue date of the original patent. The original patent, U.S. Patent No. 4,779,147, was issued on October 18, 1988. This reissue application was filed April 6, 1995.

The claimed invention is directed to a tape recorder with an automatic reversing mechanism and wherein fast forwarding or rewinding of a tape started manually is ended by releasing an operating member therefor from an actuated arresting position.

No prior art is relied upon in the rejection.

OPINION

We reverse.

35 U.S.C. 251 permits reissuance of defective patents when a "patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid..." The statute also provides that

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

Since this reissue application was filed more than two years from the grant of the original patent, we must determine whether the amended and newly added claims enlarge the scope of the claims of the original patent. Further, it must be determined whether the error alleged to have been in the original patent is of the type for which 35 U.S.C. 251 permits correction.

As is clear from a review of the original claim 1 and the amended claim 1, the subject of this appeal, and from appellants' comments, at page 7 of the brief, there was an error in claim 1 of the original patent. Whereas that claim 1 recited that the tape feeding direction change-over mechanism was operated to move the trigger member to cancel the arresting condition by said arresting mechanism, this is inconsistent with the disclosure which makes it clear, as amended claim 1 now makes clear, that the tape feeding direction change-over mechanism does not move the trigger member to cancel the

arresting condition by the arresting mechanism. Rather, the transmission member (131 in Figure 2) moves the trigger member (285 in Figure 16) and the trigger member operates the tape feeding direction change-over mechanism (126 in Figure 1). The cancellation of the arresting condition depends on whether one of the first or second operating members (108, 109 in Figure 1) is advanced while the other operating member is arrested or the reel receiving elements stop with the other operating member being arrested.

Thus, it is clear that an error occurred in the patent which makes the original patent either wholly or partly inoperative or invalid. Appellants have declared that the error occurred without any deceptive intention and the examiner does not contend otherwise. Thus, it is clear to us that the error in claim 1 of the original patent is of the type permitted to be corrected by 35 U.S.C. 251. We are in agreement with appellants that what they are doing is correcting a clear mistake which is precisely the purpose of the reissue statute.

We now analyze the change in claim language from claim 1 of the original patent to the amended claim 1 of the instant reissue application. The amendment merely changes clearly inoperative language to language which more precisely describes the proper operation of the device, including the interrelationship between the transmission member, the tape feeding direction change-over member, the trigger member, the arresting mechanism and the first and second operating members. We find nothing in this amendment which broadens the scope of the claim as a whole in any manner whatsoever.

While the examiner has alleged that the added limitations "involve an undue broadening of the claimed invention" [answer, page 7], it is not clear from the examiner's rationale what, exactly, is alleged to have been broadened. The sole reasoning of the examiner appears to be that amended claim 1, instead of encompassing a single operating state, establishes plural operational states in that, now, either the first or second operating member is given the potential of being advanced [answer-bottom of page 4] and/or that the recitation regarding "when the reel receiving elements stop...the arrested condition

of the other operating member is canceled by activation of the TFDCO member" involves an unacceptable broadening of the claimed invention [answer-page 5].

Our review of the amended claim finds no such broadening of the claim scope. Any encompassing of "plural operational states," as the examiner calls it, is only a consequence of the now amended claim language to point out that it is the transmission member which moves the trigger member and the trigger member operates the tape feeding direction change-over mechanism and that the cancellation of the arresting condition depends on whether one of the first and second operating members is advanced while the other operating member is arrested or the reel receiving elements stop with the other operating member being arrested. We do not find that the further specification of the conditions under which certain actions take place constitutes a broadening of the claim scope.

Similarly, with new claim 4, while the examiner indicates that the claim scope is broader than that of claim 1 in the original patent, because the claim now recites that the

transmission member, in contrast to the TFDCO member, operates the trigger member which in turn operates the TFDCO member, we find no such broadening. The examiner has not indicated what, exactly, is alleged to have been broadened. As with claim 1, we find that this addition of claim 4 merely corrects an obvious error in the original patent and we find no basis, on the record before us, for finding that either amended claim 1 or newly added claims 4 through 6 constitutes a broadening of the claimed subject matter within the meaning of 35 U.S.C. 251.

The examiner's decision is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JOHN C. MARTIN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	

Appeal No. 1998-0454
Application No. 08/417,985

Page 8

ANITA PELLMAN GROSS)
Administrative Patent Judge)

EAK/jlb

Appeal No. 1998-0454
Application No. 08/417,985

Page 9

EVENSON McKEOWN EDWARDS & LENAHA
SUITE 700
1200 G STREET NW
WASHINGTON, DC 20005